

REMARKS

Claims 1, 2, 4-19, 21-23, 25-28, 30-45, 53, and 59-66 are pending herein, with Claims 1, 53, 59, 66, and 67 being independent claims. Claims 46-52 and 54-57 are cancelled herein. Claim 67 is new. All claims stand rejected.

35 U.S.C. § 101:

Claims 1, 2, 4-19, 21-28, and 30-57 were rejected under 35 U.S.C. §101 as being directed towards nonstatutory subject matter. Specifically, the Examiner stated that the steps or processes as claimed herein should be implemented via a device such as a computer system or a database. The Applicant respectfully traverses the rejection.

The focus of a §101 inquiry is whether the process has "practical utility," *i.e.*, whether the claimed process produces a "useful, concrete, and tangible result." *See State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1602 (Fed. Cir. 1998). The Applicant submits that the amendments made herein easily provide such a "useful, concrete, and tangible" result, *i.e.*, creating a demand for an item through the selection of messaging, brands, packaging, or merchandising.

Further, the Federal Circuit has made it clear that a method or process claim need *not* recite any specific structure for carrying out the process. *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447, 1453 (Fed. Cir. 1999). Similarly, the unpublished Board decision cited by the Examiner, *Ex Parte Bowman*, 61 USPQ2d 1669 (Bd. Pat. App. & Int. 2001) does not (and could not) command a different conclusion. In *Bowman*, the Board affirmed the rejection of a method claim under 35 U.S.C. §101. In that case, there was no mention of any technology in either the claims or the specification. "The examiner responds that the noted [Computer Related Inventions] Guidelines are inapplicable here because appellant has not recited the use of a computer in either the specification or the claims." 61 USPQ2d at 1671. One member of the Board specifically noted that the use of a computer or other type

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of operating environment may be inferred based upon *In re Dossel*, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997) rather than being specifically recited. Likewise, the use of any type of specific structure is no longer required under the *AT&T* decision:

While *AT&T* clarifies that structure need not be present in the claim language for process claims to be directed to statutory subject matter, the Court appears to impliedly weight that the process is carried out by a network of computers and telephone switches being used in the flow of communications, but here we do not have a similar factual situation.

Id. at 1674 (Dixon, J., concurring).

Here, as recited above, the specification describes in great detail the various ways by which the consumer lifestyle and market data may be gathered and analyzed with and without computers. Although a computer or a database could play a large role in such steps, the prior art does not require that the claims be so limited. The Applicant thus submits that the claims meet statutory requirements of 35 U.S.C. §101.

37 C.F.R. §1.75(c):

Claims 44 and 45 were rejected under 37 C.F.R. §1.75(c) as being in improper dependent form for failing to further limit the subject matter of Claims 1 and 39 respectively. Claims 44 and 45 recite "a computer readable medium having computer executable instructions for performing the steps recited in" Claims 1 and 39. MPEP §2173.05(f) specifically states that such claims are allowable, i.e., "[t]he product produced by the method of claim 1." Given the clear statement of the MPEP and given the dozens of examples of issued claims in exactly this format with exactly this language, the Applicant is prepared to take this issue to the Board.

35 U.S.C. § 112:

Claims 1, 2, 4-19, 21-28, 30-45, 46-52, 53, 54-57 were rejected under 35 U.S.C. §112, first paragraph, as being based upon a disclosure that is not enabling. The Applicant submits that the

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amendments previously made render the rejection moot. Specifically, the demand step is now based upon "one or more representative uses of said item by said predetermined type of consumer during said one or more representative activities through the selection of messaging, brands, packaging, or merchandising." Thus the demand recited in the claim is tied to the determined activities and the determined uses of the item during those activities. The Applicant further asserts that there are no essential steps necessary to carry out the invention missing from the claims.

The same claims were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for the same reasons. The Applicant again submits that the amendments previously made render this rejection moot.

Election/Restriction:

The application was restricted to one of three groups:

Group I (Claims 1-2, 4-19, 21-28, 30-45, 53, and 59-65);

Group II (Claims 46-52); and

Group II (Claims 54-57 and 66).

The Applicant elects the Group I claims, with traverse. The Applicant cancels Claims 46-52 and 54-57.

The Applicant respectfully traverses the restriction of Claim 66. The Group III claims were described as "drawn to a method or system for measuring or determining effectiveness of a marketing campaign related to an item by deploying solutions within a purchasing environment to create demand for said item by one or more shoppers."

Claim 66, however, states as follows:

66. A system for facilitating the use of an item by a predetermined type of consumer comprising:
a storage device; and

a processor connected to said storage device,
said storage device storing a program for controlling the processor;
said storage device storing data representing one or more activities
of said predetermined type of consumer,
said storage device storing data representing one or more needs of
said predetermined type of consumer for said item;
said storage device storing data representing one or more
marketing solutions promoting the use of said item by said predetermined type of
consumer based upon the selection of messaging, brands, packaging, or
merchandising; and
said processor operative with said program to receive a request for
said one or more marketing solutions based upon said one or more activities or
said one or more needs of said predetermined type of consumer and to provide
said one or more marketing solutions.

As is apparent, Claim 66 does not address the effectiveness of a marketing
campaign. Rather, Claim 66 more properly belongs with the Group I claims.

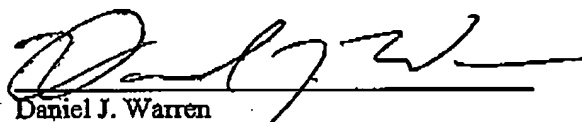
New Claim:

New Claim 67 is similar to Claim 1, but adds the database limitation and other changes.

CONCLUSION

The Applicant believes that it has responded to each matter raised in the Office Action. Allowance of all claims is respectfully solicited. Any questions may be direct to the undersigned at 404.853.8028.

Respectfully submitted,


Daniel J. Warren
Reg. No. 34,272**SUTHERLAND ASBILL & BRENNAN LLP**

999 Peachtree Street, N.E.
Atlanta, Georgia 30309-3996
(404) 853-8000
daniel.warren@sablaw.com

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